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09/744,595	01/26/2001	Kojiro Okamoto	0819-416	1644

7590

07/07/2004

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EXAMINER
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ORTIZ CRIADO, JORGE L

ART UNIT	PAPER NUMBER
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2655

DATE MAILED: 07/07/2004

16

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Advisory Action**

Application No.

09/744,595

Applicant(s)

OKAMOTO ET AL.

Examiner

Jorge L Ortiz-Criado

Art Unit

2655

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 6/4/04 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 12-20.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

W. R. YOUNG  
PRIMARY EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments filed 06/04/2004 have been fully considered but they are not persuasive.

Applicant's response to the rejection of claims 12, 13 and 20 as unpatentable over Lokhoff et al. in view of Timmermans et al.

Applicant argued that Lokhoff et al. does not teach or suggest a second recording region having a track

"along which information pits are formed to record a signal representative of control information... wherein said control information... includes... an invalid key information item... for inhibiting reproduction of main data in the primary recording region."

Applicants argued that Lokhoff et al. alone does not teach or suggest certain features as claimed in claim 12.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this case, claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lokhoff et al. in view of Timmermans et al.

Lokhoff et al. further discloses a control information in said secondary recording region for indicating which type(s) of information is copied into said primary recording region for inhibit if it detected to be of a type indicated by the control information being read from the recording medium (See col. 1, lines 40-55; col. 2, lines 50-58; Fig. 3a, 3c)

Lokhoff et al. does not expressly disclose wherein said control information in said secondary recording region includes, an invalid key information item for inhibiting reproduction of main data encrypted in said primary recording region and this feature is well known in the art as evidenced by Timmermans et al., which discloses a recording medium which includes, as data, an invalid key information item for inhibiting/enabling/disabling reproduction of main data encrypted in said primary recording region (See col. 7, lines 1-16);

Applicants argued that Timmermans does not disclose an "invalid information item for inhibiting reproduction of main data encrypted". Also argued that the cited portion of Timmerman's discloses only a de-encryption code and the code is not the same as claimed "invalid key information item" which inhibits reproduction.

The Examiner cannot concur because Timmermans et al. discloses an "invalid key information item for inhibiting /not-enabling/enabling/disabling reproduction of main data encrypted", Timmermans et al. discloses recovering the invalid key/code from the secondary recording region and compare this invalid key/code to inhibit/enabling/disabling the reproduction of the encrypted data and in addition further preferably include a de-encryption key code for decrypt the main data encrypted (col. 6, line 45 to col. 7, line 21).

Applicants argued that Timmermans et al. or Lokhoff et al. does not teach or suggest of "information pits are formed".

The Examiner cannot concur because, Lokhoff et al. discloses secondary recording region has a track which wobbles at a second pitch different from said first pitch or does not wobble, in which pattern of pits are recorded (as shown in Fig. 3a, 3c; col. 6, lines 20-35) including a control information in said secondary recording region for indicating which type(s) of information is copied into said primary recording region for inhibit if it detected to be of a type indicated by the control information being read from the recording medium (See col. 1, lines 40-55; col. 2, lines 50-58; Fig. 3a, 3c) and the combination of Lokhoff et al. with Timmermans et al. shows "invalid key/code information item for inhibiting /not-enabling/enabling/disabling reproduction of main data encrypted", as teaches by Timmermans et al. (see Timmermans et al. col. 6, line 45 to col. 7, line 21).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, it would have been obvious to one with ordinary skill in the art at the time of the invention to provide a control information prerecorded in said secondary recording region for indicating which type(s) of information is copied into said primary recording region for inhibit if it detected to be of a type indicated by the control information being read from the recording medium as teaches by Lokhoff et al. an further includes an invalid key information item for inhibiting reproduction of main data encrypted in said primary recording region as suggested by Timmermans et al, in order to prohibit illegal copies of the disk, which is a well know problem that both Lokhoff et al. and Timmermans et al. are present as an object of their inventions.

Applicant's response to the rejection of claims 15-19, as unpatentable over Lokhoff et al. in view of Timmermans et al.

Applicants argued that the combination specifically Timmermans et al. does not teach or suggest, "in a case where according to said means for distinguishing the reproduction location of said recording medium, the reproduction location is said primary recording region having said track pitch which wobbles at said first pitch, and the main data encrypted in said primary recording region are being recorded, said pickup is shifted to said secondary recording region by said means for shifting said pickup and the reproduction of the main data encrypted in said primary recording region is inhibited by the invalid key information item included in said control information in said secondary recording region

The Examiner cannot concur, because Timmermans et al. discloses distinguishing if a reproduction location of said recording medium is the track that wobbles as said first pitch or the track that wobbles at said second pitch different from said first pitch or does not wobble, (see col. 6, lines 12-49) and maintaining shifting/scanning the pickup until the wobbles at said second pitch different from said first pitch of the secondary recording region is detected (See col. 6, lines 45-56). In the case of the detection of said second pitch different from said first pitch of the secondary recording region the recovery of the information recovery is enable, which includes an invalid key/code information item for inhibiting/enabling/disabling reproduction of the encrypted main data and after and a comparison/detection of the invalid key/code information item the reproduction of the main data encrypted in the primary recording region is inhibited/enabled/disabled. (See col. 6, line 45 to col. 7, line 21)